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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,975	01/20/2004	Bettina Walter	MS1-1801US	3480
22801	7590	12/05/2007		
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			EXAMINER WHIPPLE, BRIAN P	
			ART UNIT	PAPER NUMBER
			2152	
			MAIL DATE	DELIVERY MODE
			12/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/760,975

Applicant(s)

WALTER ET AL.

Examiner

Brian P. Whipple

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1/20/04, 1/3/05, 4/7/05, 4/11/05, 2/7/06, 9/18/06, 7/18/07, 9/19/07.

DETAILED ACTION

1. Claims 1-36 are pending in this application and presented for examination.

Information Disclosure Statement

2. The information disclosure statement filed 04/07/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Applicant failed to provide a copy of WO 2004/004139.

Additionally, Applicant lists 2002178230 which is not a valid U.S. Patent Publication number. A U.S. Patent Publication number consists of the 4-digit year code followed by a 7-digit identifier. Therefore, the relevant document could not be located.

3. The information disclosure statement filed 4/11/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

European Search Report for EP Application No. 04102579.2 is listed, but no copy is provided. Applicant merely provided the abstract for EP Application No. 04102579.2.

Additionally, any relevant U.S. Patent Documents and Non Patent Literature documents from the European Search Report should be included in an Information Disclosure Statement and Applicant should provide the relevant Non Patent Literature documents.

4. The information disclosure statement filed 2/7/06 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

U.S. Patents citation numbers 1-7 consist of 6-digit identifiers. A valid U.S. Patent No. consists of 7 digits. Therefore, the relevant documents could not be located.

Additionally, Non Patent Literature citation number 5 lists the title as "The ABC's of IP Version 6", but should read "The ABCs of IP Version 6."

5. The information disclosure statement filed 9/18/06 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

EP0665670 and WO2005017660 are listed, but no copies are provided.

Additionally, Applicant lists 2002178230 which is not a valid U.S. Patent Publication number. A U.S. Patent Publication number consists of the 4-digit year code followed by a 7-digit identifier. Therefore, the relevant document could not be located.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 23-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. As to claims 23-29, the system may be interpreted as comprising only software (see pg. 11, ln. 7-10 of Applicant's disclosure). Software fails to fall into one of the four statutory classes of invention: process, machine, manufacture, or composition of matter.

9. As to claims 30-36, the applicant's disclosure indicates the applicant intends computer-readable media to cover communication media such as signals (see pg. 20, ln. 8-12; pg. 20, ln. 21—pg. 21, ln. 5). Such mediums fail to fall into one of the four statutory classes of invention: process, machine, manufacture, or composition of matter.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-9, 11-16, 21, 23-26, and 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danker et al. (Danker), U.S. Publication No. 2002/0184309 A1, in view of Nelson, U.S. Publication No. 2004/0018858 A1.

12. As to claim 1, Danker discloses selecting pixels to be used as an emoticon (Fig. 6A-6B; [0074]; the transmission of a character sequence for assigning a status icon is the selection of pixels to be used as an emoticon);

assigning a character sequence to the pixels (Fig. 6A-6B; [0074]); and

transmitting the character sequence to a destination to allow for reconstruction of the pixels at the destination (Fig 6A-6B; [0075]).

If the applicant feels that Danker does not explicitly or inherently disclose selecting pixels to be used as an emoticon, Nelson discloses selecting pixels to be used as an emoticon (Fig. 2; [0030], ln. 5-17; “singular graphical symbols, such as ☺ may be employed instead”).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Danker by selecting pixels to be used as an emoticon as taught by Nelson in order to display graphical icons available for transmission to another user to a user without the need to “enter the emoticon forming characters one at a time” ([0006], ln. 9-10).

13. As to claims 7, 14, 21, 23, and 30, the claims are rejected for the same reasons as claim 1 above.

14. As to claim 2, Danker and Nelson disclose the invention substantially as in parent claim 1 above, including the pixels comprise a pixel array of pre-determined dimensions (Danker: Fig. 6A-6B; Nelson: Fig. 2).

15. As to claim 3, the claim is rejected for the same reasons as claim 2 above (the definition of the grid as 19 x 19 is merely a design choice, it is known in the art that an icon may be constructed to conform to various pixel dimensions).

16. As to claim 4, Danker and Nelson disclose the invention substantially as in parent claim 1, including the character sequence allows real-time mapping to the pixels (Danker: [0074] – [0075]).

17. As to claim 5, Danker and Nelson disclose the invention substantially as in parent claim 1, including parsing the character sequence into an object name for the pixels, wherein the object name includes an identifier of the pixels and a location of the pixels (Danker: [0073] – [0075]; it may be interpreted that in order to map the character sequence to a

graphical icon, the object must be identified and located, for placement on the screen of the intended user; the graphical icon and/or character sequence must be an object given a name in order to properly map and display graphical icons).

18. As to claims 6, 25, and 33, the claims are rejected for the same reasons as claim 21 above.

19. As to claims 8-9, 11, 26, 32, and 34, the claims are rejected for the same reasons as claim 5 above.

20. As to claim 12, the claim is rejected for the same reasons as claims 1 and 5 above.

21. As to claim 13, the claim is rejected for the same reasons as claim 12 above. It is known in the art that instant messaging transmission has a limited data capacity and that a limited number of text characters are transmitted in each individual message at the time of the invention. If the number of characters is limited and transmission of the lengthy message is denied, then the data representing the pixels in a single (the same) instant message will also be excluded from transmission. Therefore, such a feature may be interpreted as being included in the teachings of Danker and Nelson.

22. As to claim 15, the claim is rejected for the same reasons as claim 8 above.

23. As to claim 16, the claim is rejected for the same reasons as claim 9 above.

24. As to claim 24, the claim is rejected for the same reasons as claim 1 above. Emoticons were created and mapped to character sequences by the provider of the instant messaging or phone services mentioned in the teachings of Danker and Nelson. Since the user interface is not required to be client-side by the claim, it may be interpreted that the provider of the service mapped custom emoticons to character sequences that are then implemented by users of the service.

25. As to claims 28-29, the claims are rejected for the same reasons as claim 11 above.

26. As to claim 31, the claim is rejected for the same reasons as claim 4 above.

27. As to claims 35-36, the claims are rejected for the same reasons as claims 1 and 11 above.

28. Claims 10, 17-20, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danker and Nelson as applied to claims 9, 14, 21, and 26 above, and further in view of what was well known in the art.

29. As to claim 10, Danker and Nelson disclose the invention substantially as in parent claim 9, but do not explicitly teach the object name is stored in a header of the message.

Official Notice (see MPEP 2144.03) is taken that it was well known in the art at the time of the invention to store an object name in a header as is common practice in the art and would be expected for the purposes of transmitting an object between nodes.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Danker and Nelson by storing an object name in a header to get this well-known feature.

30. As to claims 17-20, Danker and Nelson disclose the invention substantially as in parent claim 14, but do not explicitly teach caching on a local storage medium such as a cache of temporary files used by a web browser; obtaining information from a local storage medium, or failing such a connection, from a server; and the use of a peer-to-peer connection using either TCP or UDP.

Official Notice (see MPEP 2144.03) is taken that it was well known in the art at the time of the invention to cache files either locally or on a server and to use peer-to-peer connections through TCP or UDP for transmission of files for the purposes of avoiding the unnecessary transmission of information already previously transmitted to a node and in order to transmit information directly from peer-to-peer absent the use of a server. TCP or UDP are the main methods of communication in Internet communications such as those disclosed in Danker and Nelson and it would thus be expected that either TCP or UDP is being implemented.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Danker and Nelson by caching on a local storage medium such as a cache of temporary files used by a web browser; obtaining information from a local storage medium, or failing such a connection, from a server; and the use of a peer-to-peer connection using either TCP or UDP to get this well-known feature.

31. As to claim 22, Danker and Nelson disclose the invention substantially as in parent claim 21, but do not explicitly teach adapting images of various sizes and formats to a pixel array format of predetermined size, for use as the graphics data of emoticons ("for use as the graphics data of emoticons" is intended use and therefore not given weight).

Official Notice (see MPEP 2144.03) is taken that adapting images of various sizes and formats to a pixel array format of predetermined size was well known in the art at the time of the invention.

Applicant fails to disclose the step as occurring automatically. Therefore, methods such as a user cropping and/or shrinking an image prior to use (such as the requirement for buddy icons to meet pixel dimension requirements) was well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Danker and Nelson by adapting images of various sizes and formats to a pixel array format of predetermined size to get this well-known feature.

32. As to claim 27, the claim is rejected for the same reasons as claim 10 above.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892).

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Whipple whose telephone number is (571) 270-1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPW

Brian P. Whipple
11/29/07



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

11/30/07